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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,708	12/17/1999	FUMIKO SEMBA	FUJI-16.863	9208

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EXAMINER

AL AUBAIDI, RASHA S

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/465,708

Applicant(s)

SEMBA ET AL.

Examiner

Rasha S AL-Aubaidi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al (US Patent 6,574,216).

Regarding claim 14, Farris specifically teaches the switching of the telephone call in progress, and currently connected via the Internet (50, Fig. 3) to another non-internet network (PSTN 10, Fig. 3) in order to **improve voice quality**. See abstract, col. 9, lines 35-58 and col. 11, lines 22-58. The claimed "exchange" reads on the combination of SSP 13 and Internet module 92. Pressing the "*" digit on the caller's telephone 11 during an economical Internet call will switch the call from Internet 50 to the PSTN 10 to improve the voice quality. The Internet may be selected when the caller dials a code such as *82 or based on the caller's routing criteria in his/her CPR (col. 9, lines 35-58).

Farris differs from the claims only in the way the caller signals his/her desire to switch from the Internet to PSTN during a telephone call via the Internet. In Farris, the caller signals his/her desire to switch from the Internet to PSTN by dialing the "*" digit which is detected by Internet module 92 during a telephone call via the Internet. However, in the claimed invention, the caller signals his/her desire to switch from the

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Internet to PSTN by pushing a button after a "quick" on-hook/flash operation during a telephone call via the Internet.

The difference is merely in the specific way the caller signals the exchange ("SSP 13 and module 92"). The use of on-hook/flash operation to signal an exchange is old and well known. For example, a quick or temporary on-hook or flash operation maybe used to establish a conference call, to answer a call in response to a call waiting tone ... etc. Thus, obviously one of ordinary skill in the art may use any type of signal ("*" in Farris, or pushing a button after a flash operation in the claims) in order to accomplish the same exact result for the same exact purpose. Simply using another signal in Farris does not rise to the level of patentability.

When the calling party in Farris wishes to switch the call from the Internet to the PSTN, he/she dials *82 only. The calling party does not dial the telephone number of the called party when he/she decides to switch from the Internet to PSTN. The PSTN will inherently need the number of the called party to connect the calling party to the called party. Therefore, it is inherent or at least very obvious, that the "exchange" in Farris will have to store the telephone number of the called party to effect the switching. In both, the claimed invention and Farris, the connection through the Internet has to be disconnected and a new connection through the PSTN has to be "originated"; thus "re-originating" the call between the calling and the called parties.

Claims 15-16 are rejected for the same reasons as discussed above with respect to claim 11.

Response to Arguments

3. Applicant's arguments have been fully considered but they are not persuasive.
Applicant's arguments have been already addressed in the above rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (703)

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605-5145. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Examiner

Rasha S. al-Aubaidi

06/15/2004


AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700